

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

9

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/378,577 08/20/99 SHI

W 60307-5001

EXAMINER

HM12/0816

JEFFER MANGELS BUTLER & MARMARO LLP
TENTH FLOOR
2121 AVENUE OF THE STARS
LOS ANGELES CA 90067

ZEMAN, R

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

08/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
09/378,577Applicant(s)
Shi et al.Examiner
Robert A. ZemanArt Unit
1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jul 26, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attached

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).

6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-17

9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.

10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

11. ☒ Other: See attached "Changes to the Patent Rules"

Art Unit: 1645

ADVISORY ACTION

The amendment filed 7-26-2001 under 37 CFR 1.111 (amendment should have been filed under 37 CFR 1.116) in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

- The proposed amendment does not comply with revised rule 37 CFR 1.121 (see attachment).
- The proposed amendment raises new issues that would require further consideration and/or search. The proposed amended claims recite the limitations “binds to at least one cariogenic organism” (claim 1) and “antigens displayed by cariogenic organisms”. Said limitations suggest that the claimed chimeric antibodies are cross-reactive. This constitutes a new consideration requiring additional searching and examination.
- The rejection of claims 5, 11 and 13-16 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the topical treatment using chimeric monoclonal antibodies, does not reasonably provide enablement for the treatment for the oral ingestion of tissue from transformed host is maintained for reasons of record. Applicants arguments are based, in part, on exhibits not of record. Said exhibits have not been entered or considered since there is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented. Said exhibits and arguments could have been made in response to Office action filed on 4-12-2000. It should be noted that

Art Unit: 1645

said arguments are deemed non-persuasive and said rejection would be maintained even if the aforementioned exhibits and arguments were considered.

- The rejection of claims 1, 6 and 7 under 35 U.S.C. 102(b) as being anticipated by Lehner (U.S. Patent 5,352,446) is maintained for reasons of record. It should be noted that the amendment filed 7-26-2000, if entered, would be sufficient to overcome said rejection.
- The rejection of claims 1-4, 6-10, 12 and 17 under 35 U.S.C. 103(a) as being unpatentable over Ma et al. (European Journal of Immunology 1994 Vol. 24 (1) pages 131-138) in view of Adair et al (U.S. Patent 5,877,293) is maintained for reasons of record. Applicants arguments are based, in part, on exhibits not of record. Said exhibits have not been entered since there is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented. Said exhibits and arguments could have been made in response to Office action filed on 4-12-2000. It should be noted that said arguments are deemed non-persuasive and said rejection would be maintained even if the aforementioned exhibits and arguments were considered.


Art Unit: 1645

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Lynette Smith, can be reached at (703)308-3909.


DONNA WORTMAN
PRIMARY EXAMINER

Robert A. Zeman

August 14, 2001